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EXAMINER

BRITTAIN, JAMES R

ART UNIT PAPER NUMBER

3677

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,396

Applicant(s)

CAHILL, JAMES

Examiner

James R. Brittain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-13, 15, 16 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-9, 16, 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 9-13, 15, 23-26 and 31 is/are rejected.
- 7) ☒ Claim(s) 27-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

The indicated allowability of claims 10-13, 24, and 26 is withdrawn in view of the newly discovered reference(s) to Tinkey (US 3217955), Mango (US 3746285), Nelson (US 589093), and Vara (US 5531333). Additionally, claims 15 and 31 are newly rejected on art based on Boyd (US 4499341). Rejections based on the newly cited reference(s) follow.

Claims 3-9, 16, 21, and 22 are allowed.

Claims 27-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the tether adapted to carry an electrical signal indicating connection of the fastener to an item in a dispenser (claims 15 and 31) comprising a stratified body (claim 23) or carrying separable subtethers (claim 25) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15 and 31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not known how the tether is adapted to carry an electrical signal indicating connection of the fastener to an item.

Claims 23 and 25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not known how the tether is adapted to carry an electrical signal indicating connection of the fastener to an item in a dispenser comprising a stratified body or carrying separable subtethers.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claim 15 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Boyd (US 4499341).

Boyd (figures 1, 2, 4) teaches extensible electrical cable structure 16 with a fastener 24 at one end fully capable of securement to an item. The cable is extractably stored in a dispenser 44 that is attachable to a substrate. The device is inherently usable to secure an item to fastener 24 and the dispenser to a container and have the electrical cable carry a signal indicating whether the fastener 24 is connected to the item. Applicant is reminded that if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim 15 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Vara (US 5531333).

Vara (figures 4, 6) teaches extensible electrical cable structure 86 with a fastener in the form of the jack at one end 84 fully capable of securement to an item. The cable is extractably stored in a dispenser 10 that is attachable to a container 100. The device is inherently usable to secure an item to the jack, which is then placed in the container under obscuring material, and have the electrical cable carry a signal indicating whether the jack is connected to the item. Applicant is reminded that if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claims 10 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Tinkey (US 3217955).

Tinke (figures 1, 2) teaches tether structure wherein the tether is tape 24 that is inherently subdividable to form subtethers through the fact that it can be cut into pieces of different configuration. The tether through being adhesive has a fastener in the form of adhesive at an end. The dispenser 10 has slots 14 that inherently make the dispenser attachable to a container and the tether in the form of adhesive tape is extractable from the dispenser. Applicant is reminded that if the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Boyd (US 4499341) or Vara (US 5531333), each taken in view of Sinsko (US 4532972).

Boyd (figures 1, 2, 4) teaches extensible electrical cable structure 16 with a fastener 24 at one end fully capable of securement to an item. The cable is extractably stored in a dispenser 44 that is attachable to a substrate. The device is inherently usable to secure an item to fastener 24 and the dispenser to a container and have the electrical cable carry a signal indicating whether the fastener 24 is connected to the item. Additionally, Vara (figures 4, 6) teaches extensible electrical cable structure 86 with a fastener in the form of the jack at one end 84 fully capable of securement to an item. The cable is extractably stored in a dispenser 10 that is

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attachable to a container 100. The device is inherently usable to secure an item to the jack, which is then placed in the container under obscuring material, and have the electrical cable carry a signal indicating whether the jack is connected to the item. The difference is that neither uses a badge for indicia. However, Sinsko (figure 1) teaches that to readily locate items tethered 23 within a purse and to find them rapidly (Abstract) that it is desirable to secure the tethered object to an anchored plate with the object identified by indicia. It would have been obvious to modify the extractable tethers of either Boyd or Vara such that indicia is carried on a badge on the casing to identify the tethered item in view of Sinsko teaching that to readily locate items tethered 23 within a purse and to find them rapidly (Abstract), it is desirable to secure the tethered object to an anchored plate with the object identified by indicia.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al. (US 5989093) in view of Vara (US 5531333).

Nelson et al. (figures 1, 4, 5) teach a tethering device comprising a tether 42 extractably stored in a dispenser 12. A pad 14 is secured to an end of the tether. The tab has an attachment eyelet in the form of slot 20 for securement of the tether. An adhesive is attached to the tab and is attachable to an item. The tab is a widened portion of the tether. The dispenser is inherently attachable to a container. However, there is no showing of how a spool shaped dispenser would be attachable to a container. Vara (figures 4, 6) teaches extensible electrical cable structure 86 with a fastener in the form of the jack at one end 84 fully capable of securement to an item. The cable is extractably stored in a reel-type dispenser 10 that is attachable to a container 100. The device is inherently usable to secure an item to the jack, which is then placed in the container under obscuring material, and have the electrical cable carry a signal indicating whether the jack

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is connected to the item. As Vara shows that the edges of the reel-type container are fully capable of being secured to a container, it would have been obvious to realize that the dispenser of Nelson et al. is also attachable to a container.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mango (US 3746285) in view of Nelson et al. (US 5989093).

Mango (figures 1-3) teaches extractable tethering device for a balloon secured to a container including the dispenser 17 attached to the container and tether 18 having a fastener in the form of threaded cap 23 that is wider than the tether has an attachment eye for securement to the tether and is securable to the item that could be obscured by packing material. The difference is that the fastener is a cap and not a pad. However, Nelson et al. (figures 1, 4, 5) teach a tethering device comprising a tether 42 for a balloon extractably stored in a dispenser 12. A pad 14 is secured to an end of the tether. The tab has an attachment eyelet in the form of slot 20 for securement of the tether. An adhesive is attached to the tab and is attachable to an item. The tab is a widened portion of the tether and permits easy attachment to an item. As it would be beneficial to make the attachment of the device of Mango to an item easier, it would have been obvious to modify the device of Mango to utilize a widened pad as taught by Nelson et al. so as to more easily secure the item.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tinkey (US 3217955) in view of Sinsko (US 4532972).

Tinkey (figures 1, 2) teaches tether structure wherein the tether is tape 24 that is inherently subdividable to form subtethers through the fact that it can be cut into pieces of different configuration. The tether through being adhesive has a fastener in the form of adhesive

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at an end. The dispenser 10 has slots 14 that inherently make the dispenser attachable to a container and the tether in the form of adhesive tape is extractable from the dispenser. The difference is it lacks a badge for indicia. However, Sinsko (figure 1) teaches that to readily locate items tethered 23 within a purse and to find them rapidly (Abstract) that it is desirable to secure the tethered object to an anchored plate with the object identified by indicia. It would have been obvious to modify the extractable tether of Tinkey such that indicia is carried on a badge on the casing to identify the tethered item in view of Sinsko teaching that to readily locate items tethered 23 within a purse and to find them rapidly (Abstract), it is desirable to secure the tethered object to an anchored plate with the object identified by indicia.

Response to Arguments

Applicant's arguments filed September 24, 2003 have been fully considered but they are not persuasive.

Applicant directs attention to U.S. Patent No. 6,212,741, which is incorporated by reference in the present application and then states "The disclosure regarding electrical reaction which shows attachment of the tethered item can be seen in Figure 10B and which is further described in column 6, lines 11-15. The rejected claims merely require that the tether is adapted to carry an electrical signal indicating connection of the fastener to an item. Applicant submits that it is well within the skill of the art to metalize the tether such as forming it into a wire such that it would carry an electrical signal." (page 1, ¶2). It is appropriate to review Figure 10B and column 6, lines 11-15 of U.S. Patent 6,212,741. Figure 10B shows a linear element with the caption "electrical reaction shows attachment" and column 6, lines 11-15 state "The tether may be formed of a material which can carry information signifying attachment of the connector to an

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item through chemical means as in FIG. 10B, or electrical or optical means as in FIG. 10C”.

Applicant asserts that it is within the level of skill in the art to “metalize” the tether. However, there is no evidence to support this allegation, so the argument is unpersuasive.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents of Smith (US 681934, figures 1, 3), Elliott (US 1910597, figure 1), Smith (US 4384688, figures 1, 8, 9), Yoneno (US 5816458, figures 1, 3, 5), McGee (US 5864925, figures 1-4), Murphy (US 3964428, figure 1), and Watanabe (US 5011447, figure 1) teach pertinent tether structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is 703-308-2222. The examiner can normally be reached on M, W & F 5:30-1:30, T 5:30-2:00 & TH 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James R. Brittain
Primary Examiner
Art Unit 3677

JRB